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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,449	02/18/2000	Akira Ishikura	1701.86409	8178

22907 7590 02/05/2004

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER
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SHARMA, SUJATHA R

ART UNIT	PAPER NUMBER
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2684

1-2

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/506,449

Applicant(s)

ISHIKURA ET AL.

Examiner

Sujatha Sharma

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 18, 28, 34, 38 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 19, 23, 35, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 5, 18, 28, 34, 38, 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 5,18,28,34,38,41 are rejected under 35 U.S.C. 102(e) as being anticipated by Metso [US 5,920,826].

Regarding claims 5,18,28,34,38 and 41, Metso discloses a radiotelephone text transmission system. Metso discloses a phone configured to be connected to a base station via a radio channel. (See col.2, lines 30-37). Metso further discloses a control unit (504 in fig.5) for controlling the phone and a modem (312 in fig.3) for connecting the control unit and the phone (See fig.4). Metso further discloses a method where the communication apparatus is operated in one of first mode of communicating with a base station and a second mode in which the control unit controls

Art Unit: 2684

the radio communication (See summary of invention, Fig. 4 and Fig. 6 and col. 7, line 24 – col. 8, line 38). Metso further discloses a method where the phone transmits the status information to the data terminal and is displayed on the data terminal (See summary of invention and Fig. 6 where the signal strength and battery status information is displayed while the phone is in the first mode i.e. controlling communication with a base station).

### ***Response to Arguments***

Applicant's arguments filed 12/12/03 have been fully considered but they are not persuasive.

The applicant argues that Metso's invention does not teach a phone comprises a transmitter to "transmit status information of the phone to the data terminal when the communication apparatus is operated in the first mode".

The applicant is again drawn to the Metso reference Fig. 6 and col. 8, lines 18-38. Fig. 6 shows a display of the front panel of the phone on the data terminal. As indicated in col. 8, lines 18-38, when the call button on the data terminal is pressed, a call is initiated, using the data terminal, between the phone and the base station which is in fact the first mode i.e. the phone in control of the radio communication. The examiner would like to point that the second mode i.e. the control unit controlling the radio communication in fact encompasses the first mode i.e. the phone controlling the radio communication link to the base station. Further, Fig. 6 also displays the signal strength and battery indication, which is possible when the phone is in the first mode i.e. controlling the radio communication with the base station.

***Allowable Subject Matter***

1. The following is an examiner's statement of reasons for allowance:

The following is an examiner's statement of reasons for allowance of claims 6,19,23,35,39 and 40.

Lazaridis [US 5,657,345] is the closest prior art to the applicant's invention, which discloses a computer system for use with a wireless data communications network. Lazaridis discloses a method of transferring information from a wireless network to a portable computer via mobile phone. Further the mobile communication device is in communication with a radio network. However Lazaridis does not disclose a method of transferring the status information from the terminal equipment such as the computer to the communication equipment such as the hand held phone and displaying the status information in the hand held unit display. Therefore the claims 6,19,23 and 35 are allowed since the prior art does not disclose a method of transferring the status information from the terminal equipment to the mobile device for displaying to the user such status information on the mobile unit display.

***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for the

Application/Control Number: 09/506,449

Page 5

Art Unit: 2684

organization where this application or proceeding is assigned and for all official communications is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Sujatha Sharma  
January 21, 2004

  
**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**